

## **REMARKS**

Claims 1, 3, 5-7, 11-13, 16-18, 21-25, 27-29, 33-35, 38-40, 43-46, and 49-51 were pending in this application. In view of their withdrawal from consideration, Applicants have canceled claims 7, 13, 18, 29, 35 and 40, without prejudice. In order to expedite prosecution of the present application and without conceding propriety to the rejection, Applicants have canceled claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51, without prejudice, and added new claims 52-78. Applicants reserve the right to pursue the subject matter of the canceled claims in a related application(s). The new claims are fully supported by the specification as filed, *see e.g.*, page 13, lines 17-36, page 14, lines 19-29, page 16, lines 9-21, page 17, line 36 to page 18, line 10, and page 30, line 20 to page 37, line 6 and do not constitute new matter. Upon entry of this Amendment, claims 52-78 will be pending and under examination.

Applicants respectfully request the consideration of the amendments and remarks and entry of them into the record for the application.

### **I. THE REJECTION UNDER 35 U.S.C. 102(b) SHOULD BE WITHDRAWN**

Claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51 are rejected under 35 U.S.C. § 102(b) as being anticipated by Butterfield et al., 1978, Am. J. Vet. Res. 39(4): 671-674 (“Butterfield”). The Examiner contends that: (1) Butterfield “teaches a vaccine formulation comprising an attenuated influenza A/Turkey/Oregon/71, and a method comprising administering the composition to a subject”; and (2) as evidenced by Norton et al., 1987, Virology 156: 204-213 (“Norton”), the attenuated influenza A/Turkey/Oregon/71 virus of Butterfield comprises a truncation of the C-terminus of the NS1 protein. As discussed above, Applicants have canceled claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51, without prejudice. Accordingly, the rejection of claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51 under 35 U.S.C. § 102(b) as anticipated by Butterfield is moot and should be withdrawn.

For the reasons below, the rejection under 35 U.S.C. § 102(b) should not be applied to new claims 52-78. As evidenced by Norton, the attenuated influenza A/Turkey/Oregon/71 virus of Butterfield contains a virus genome with a deletion in the C-terminus of the NS1 gene that results in a NS1 protein of 124 amino acid residues. Butterfield does not teach or suggest attenuated influenza viruses containing a viral genome with a C-terminal deletion in

the NS1 gene that results in a NS1 protein of 60, 70, 99, 100, 110, 120 or 130 amino acid residues, much less methods of using such attenuated influenza viruses to elicit an immune response or prevent an infectious disease. Thus, Butterfield does not teach each and every element of the claimed invention as required for a reference to anticipate a claim. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). Accordingly, new claims 52-78 should not be rejected under 35 U.S.C. § 102(b) as anticipated by Butterfield.

## **II. THE OBVIOUSNESS-TYPE DOUBLE PATENTING**

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### **REJECTIONS SHOULD BE WITHDRAWN**

Claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, and 43-46 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,669,943. Claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,866,853 and claims 7-9 of U.S. Patent No. 6,468,544. As discussed above, claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51 have been canceled, without prejudice. Accordingly, the rejections of claims 1, 3, 5, 6, 11, 12, 16, 17, 21-25, 27, 28, 33, 34, 38, 39, 43-46, and 49-51 on the ground of non-statutory obviousness-type double patenting are moot and should be withdrawn.

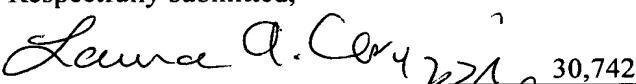
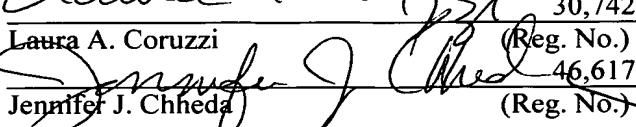
### **CONCLUSION**

Applicants respectfully request that the above-made remarks and amendments be entered and made of record in the present application. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same. An early allowance is earnestly requested.

Respectfully submitted,

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Enclosure